

Remarks

Applicant presents below his response to the non-final Office Action, and adds herein new Claim 131. Claims 117-127, 129-130, and 131 are pending with Claims 117, 127, 129, 120 and 131 in independent form. Applicant respectfully requests reconsideration.

Rejection of Claims 117-127 and 129-130 under 35 U.S.C. 103(a)

Claims 117-127 and 129-130 are rejected under 103(a) as being unpatentable over U.S. Publication No. 2004/0088261 to Moore, *et al.* ("Moore") in view of U.S. Publication No. 2002/0194094 to Lancaster, *et al.* ("Lancaster"). Applicant respectfully traverses the rejection for the reasons given below.

As the Examiner knows the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). In addressing obviousness determinations under 35 U.S.C. § 103, the Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. 398 (2007), reaffirmed many of its precedents relating to obviousness including its holding in Graham v. John Deere Co., 383 U.S. 1 (1960). In *Graham*, the Court set out an objective analysis for applying the statutory language of §103:

Under §103, the scope and content of the prior art are to be determined, differences between the prior art and the claims at issue are to be ascertained, and the level of ordinary skill in the pertinent art are to be resolved. Against this background the obviousness or non-obviousness of the subject matter is to be determined. Such secondary considerations as commercial success, long-felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *KSR* at 399 (citing *Graham*, 383 U.S. 1 at 17-18).

In *KSR*, the Court also reaffirmed that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* at 401. In this regard, the *KSR* court stated that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does . . . because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* Traditionally, to establish a *prima facie* case of obviousness, the CCPA and the Federal Circuit have required that the prior art not only include all of the claimed elements, but also some teaching, suggestion, or

motivation to combine the known elements in the same manner set forth in the claim at issue. See, e.g., ASC Hospital Systems Inc. v. Montifiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)(holding that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination); *In re Mills*, 16 U.S .P.Q.2d 1430, 1433 (Fed. Cir. 1990)(holding that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination). In *KSR*, the court noted that the demonstration of a teaching, suggestion, or motivation to combine provides a "helpful insight" in determining whether claimed subject matter is obvious. *KSR* at 401.

In addition, the *KSR* court did not diminish the requirement for objective evidence of obviousness. *Id.* at 418 ("To facilitate review, this analysis should be made explicit). See *In re Kahn*, 441 F.3d 977, 988 (C.A. Fed. 2006)("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). "As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.")

Further, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dernbiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999)(quoting W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

In the Office Action, the Examiner contends that Moore discloses the methods specified in independent Claims 117, 127, 129 and 130 with the exception Moore does not explicitly disclose the two limitations directed to:

- (1) computing a rate of return that the financial institution pays based on a duration between a periodic payment to the targeted savings plan and the at least one target date;
- (2) receiving at the first computing device instructions from the second computing device for making at least one payment on behalf of the customer, wherein the at least one payment includes at least one periodic payment to the at least one targeted savings plan and at least one payment toward the at least one customer financial obligation.

The Examiner further contends that Lancaster cures the deficiencies of Moore and discloses limitations (1) and (2) of the claims noted above. The Examiner relies on Paragraph [00748] of Lancaster as disclosing limitation (2) and relies on Fig. 2 and Fig. 6a of Lancaster as disclosing limitation (1).

Applicant does not understand the Examiner's position inasmuch as Lancaster at Paragraph [0048] fails to explicitly or implicitly disclose limitation (2) directed to receiving at least one payment on behalf of the customer, wherein the at least one payment includes at least one periodic payment to the at least one targeted savings plan and at least one payment toward the at least one customer financial obligation. In other words, this limitation of the claims is directed to targeting savings dollars in conjunction with paying at least one financial obligation as specified in the claim preambles. Lancaster fails to disclose targeting savings dollars via payment of a financial obligation.

Paragraph [0078] of Lancaster discloses:

[0078] After determining different rates for the base product (the CD account) and the associated product (the credit card account), offer determination module 550 generates a set of product combinations with different paired rates (e.g., MARKET/MARKET, HIGH/HIGH and LOW/LOW). Thus, one product combination may offer the CD and credit card accounts at market rates (market/market). Another production combination may offer the CD and credit card accounts at increased rates (HIGH/HIGH). Still another product combination may offer the CD and credit card accounts and decreased rates (LOW/LOW). Other terms and conditions of the accounts (such as Annual fees, money transfer restrictions, payment cycle definitions, usage requirements, etc.) may also be adjusted to provide different product combinations. Further, different structure rates may also be offered for the based product and associated product (MARKET/HIGH, HIGH/MARKET, MARKET/LOW, LOW/MARKET,

HIGH/LOW, LOW/HIGH, etc.).

In general, Lancaster discloses a system and method of providing a financial product to customers in association with one or more other financial products. Such financial products may correspond to different product categories. For instance, a customer may contact a financial institution about a specific financial product offered by the financial institution, referred to in Lancaster as a “base” product, such as, for example, a CD account as described in Paragraph [0078] above. The financial institution then offers one or more “associated” financial products to the customer, such as, for example, the credit card account described in Paragraph [0078] above, based on information the customer provides and/or the financial institution obtains, for instance, from public records. Such one or more associated products are then offered to the customer. (Paras. [0030] to [0033]). The yields and interest rates of the base product and the associated products are varied to meet the financial needs and preferences of the customer and/or based on a number of factors to determine an optimum combination of products to offer the customer. (Paras. [0035] and [0036]). The above Paragraph [0078] describes the possible different paired rates of return, e.g., High/High and High/Low, for a set of product combinations, e.g., CD account and credit card account. Applicant does not understand how the Lancaster disclosure of the product combination including two or more financial products with different yields or rates of return for each product teaches limitation (2) that specifies “receiving at the first computing device instructions from the second computing device for making at least one payment on behalf of the customer, wherein the at least one payment includes at least one periodic payment to the at least one targeted savings plan and at least one payment toward the at least one customer financial obligation.”

The Examiner further relies on the disclosure of “payment cycle definitions” indicated in Paragraph [0078] as teaching limitation (2). Again, Applicant fails to see how the Lancaster disclosure in general and the disclosure in Paragraph [0078] teach limitation (2) directed to paying targeted savings dollars via payment of a financial obligation.

With respect to limitation (1), the Examiner relies on Figs. 2 and 6a of Lancaster as disclosing this limitation. Fig. 2 is a process flow diagram illustrating gathering customer information and offering an associated product to a customer after customer contact regarding a base product, which does not have anything to do with computing a rate of return the financial institution pays as limitation (1) specifies. Fig. 6a is a chart that is described as an exemplary

source table that may be a source table for a CD account or a credit card account. Lancaster further provides Fig. 6b as another exemplary source table for another product. Lancaster discloses that the source tables of Figs. 6a and 6b may be used, for instance, by the offer determination module 550 to generate a set of product combinations to offer to the customer. Applicant fails to see how such use of source tables for a combination of products would disclose limitation (1).

Applicant respectfully submits that the teachings of Lancaster fail to disclose limitations (1) and (2) of Claims 117, 127, 129 and 120 as noted above and, therefore, do not correct the deficiencies of Moore. In addition, Applicant submits that where a selected combination of prior art references are relied upon to render obvious a subsequent invention, there must be some reason for combining the teachings in Moore and/or in Lancaster other than the hindsight gained from the invention itself. Other than the Examiner's statement on page 4 of the Action indicating, "... it would have been obvious to one of ordinary skill in the art to combine the teachings of Moore and Lancaster to provide maximum utility and benefit to the customers, while also providing a rate of return and benefit to the financial institution," the Examiner provides no underlying reasoning for combining the references or how the teachings of Lancaster or Moore render their combination obvious, or how such a combination renders limitations (1) and (2) of the claims obvious. Thus, the Examiner has failed to point to disclosures in the prior art references that would suggest the desirability of combining the references, as well as has failed to explain how the teachings of Lancaster would modify Moore to provide limitation (1) and (2) of the claimed invention. Applicant respectfully concludes and submits that, in this case, hindsight was employed to pick and choose among the disclosures of Moore and Lancaster to reject the claims, and the Examiner has not made a *prima facie* case of obviousness based on the cited combination of references.

In addition, *assuming arguendo* that one of ordinary skill in the art would combine the teachings of Lancaster on which the Examiner relies with Moore, the combination, as mentioned, would not achieve the invention specified in Claims 117, 127, 129 and 130. Further, the disclosures of Lancaster on which the Examiner relies do not disclose limitation (2) directed to receiving at the first computing device instructions from the second computing device for making at least one payment on behalf of the customer, wherein the at least one payment includes at least one periodic payment to the at least one targeted savings plan and at least one

payment toward the at least one customer financial obligation. Therefore, Lancaster teaches away from limitation (2) as specified in Claims 117, 127, 129 and 130.

Thus, Applicant respectfully submits that the cited combination of Moore and Lancaster does not disclose the inventions specified in Claims 117, 127, 129 and 130 and that such combination has been made in hindsight of the claimed invention. In addition, Applicant respectfully submits that Lancaster teaches away from the inventions specified in the Claims. Therefore, Claims 117, 127, 129 and 130 are not obvious and are patentable over the cited combination. Accordingly, Applicant respectfully requests withdrawal of the rejection of these Claims under § 103(a).

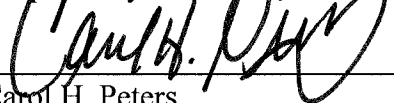
Claims 118-126 depend on independent Claim 117 and thereby incorporate each and every limitation contained in Claim 117. Therefore, Claims 118-126 are not obvious and are patentable for at least the reasons given above. Withdrawal of the rejection of Claims 118-126 is respectfully requested.

Patentability of New Claim 131

New Claim 131 is patentable over the cited prior art references for at least the reasons given above with respect to Lancaster.

Based on the foregoing discussion, the present application is believed to be in condition for allowance, and a notice to this effect is earnestly solicited. Should the Examiner have any questions concerning this response, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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